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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,315	10/22/2001	Kazuhiko Hachiya	112857-253	7385
29175	7590	12/27/2004	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			BLACKWELL, JAMES H	
			ART UNIT	PAPER NUMBER

2176

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/039,315

**Applicant(s)**

HACHIYA ET AL.

**Examiner**

James H Blackwell

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☒ Claim(s) 58-62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☒ Certified copies of the priority documents have been received in Application No. 08/993,726.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/15/02; 10/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). In addition, Figure 56 is objected to because of a spelling error; the inset text "IN FELLECT" should be spelled "INTELLECT".

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the Examiner.

### ***Claim Objections***

Claims 58-62 are objected to under 37 CFR 1.75 because Claim 58 (apparatus claim) depends from Claim 39 (method claim). For purposes of examination, it will be assumed that Claim 58 depends from Claim 54.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

### ***Double Patenting (Statutory)***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 3-4, 8-9, 16-17, 21-22, 27-28, and 33-34 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 6,311,195. This is a double patenting rejection.

***Double Patenting (Nonstatutory)***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Pending claims 1-2, 6-7, 14-15, 19-20, 25-26, and 31-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being anticipated by Claims 1, 3, 5, 7, 9, and 11 of U. S. Patent No. 6,311,195 (hereinafter Hachiya '195) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

In regard to pending independent Claim 1, Hachiya '195 anticipates "*An E-mail sending method wherein an agent is displayed on a screen and the behavior of the agent is managed by agent parameters and wherein on accepting a sending command for commanding sending of an E-mail, agent parameters determining the behavior of the agent are annexed to the main text of the mail having an appended mail header for sending the E-mail*" in Claim 1.

In regard to pending dependent Claim 2, Hachiya '195 anticipates "... *a single E-mail is sent by a single agent*" in Claim 1.

In regard to pending independent Claim 6, Hachiya '195 anticipates "*An E-mail sending apparatus, comprising: an agent manager for displaying an agent on a screen and for managing the behavior of the agent depending on agent parameters; sending command accepting means for accepting a sending command designating sending an E-mail; and mail sending means which, on accepting a sending command designating sending an E-mail by said sending command accepting means, is controlled by said agent manager for appending the agent parameters determining the behavior of the agent to the mail header or to an annexed main text of the E-mail for sending the E-mail*" in Claim 3.

In regard to pending dependent Claim 7, Hachiya '195 anticipates "... *said agent manager sends an E-mail by the single agent from said mail sending means*" in Claim 3.

In regard to pending independent Claim 14, Hachiya '195 anticipates "A method for sending/receiving an E-mail wherein an agent is displayed on a screen and the behavior of the agent is managed by agent parameters, and on accepting a sending command for commanding sending of an E-mail, agent parameters determining the behavior of the agent are annexed to the main text of the mail having an appended mail header for sending the E-mail; and wherein an E-mail is received on accepting a reception command designating reception of an E-mail and the behavior of the agent is controlled responsive to agent parameter's annexed to the received main text of the mail for displaying the agent on a screen" in Claim 5.

In regard to pending dependent Claim 15, Hachiya '195 anticipates "*a single E-mail is sent by a single agent*" in Claim 5.

In regard to pending independent Claim 19, Hachiya '195 anticipates "An apparatus for sending/receiving an E-mail, comprising: an agent manager for displaying an agent on a screen and for managing the behavior of said agent responsive to agent parameters; sending command accepting means for accepting said sending command designating sending an E-mail; mail sending means which, on accepting said sending command designating sending an E-mail by said sending command accepting means, annexes agent parameters determining the agent behavior to the main text of a mail having an appended mail header for sending the E-mail; reception command accepting means for accepting a reception command designating the reception of an E-mail; and receiving means for receiving an E-mail on accepting a reception command designating the reception of the E-mail by said reception command accepting means" in Claim 7.

In regard to pending dependent Claim 20, Hachiya '195 anticipates "*sending command accepting means for accepting said sending command designating sending an E-mail*" in Claim 7.

In regard to pending independent Claim 25, Hachiya '195 anticipates "*A sending program supplying medium for an E-mail for supplying an E-mail sending program that can be read out and executed by a computer wherein an agent is displayed on a screen and the behavior of the agent is managed by agent parameters, wherein on accepting a sending command for commanding sending of an E-mail, agent parameters determining the behavior of the agent are annexed to the main text of the mail having an appended mail header for sending the E-mail*" in Claim 9.

In regard to pending dependent Claim 26, Hachiya '195 anticipates "... *a single E-mail is sent by a single agent*" in Claim 9.

In regard to pending independent Claim 31, Hachiya '195 anticipates "*A sending/receiving program supplying medium for an E-mail for supplying an E-mail sending/receiving program that can be read out and executed by a computer wherein an agent is displayed on a screen and the behavior of the agent is managed by agent parameters; on accepting a sending command designating sending of an E-mail, agent parameters determining the behavior of the agent are annexed to the main text of the mail having an appended mail header for sending the E-mail; an E-mail is received on accepting a reception command designating reception of an E-mail; and the behavior of an agent is controlled responsive to agent parameters annexed to the received main text of the mail for displaying the agent on a screen*" in Claim 11.



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In regard to pending dependent Claim 32, Hachiya '195 anticipates "... a *single E-mail is sent by a single agent*" in Claim 11.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5-7, 10-15, 18-20, 23-26, 29-32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (hereinafter Cook, U.S. Patent No. 5,727,950), in view of Frantz (U.S. Patent No. 6,003,070).

In regard to independent Claim 1, Cook discloses, "an agent is displayed on a screen" (319 in Fig. 3) and "the behavior of the agent is managed by agent parameters" (Col. 35, lines 58-67). Cook also teaches that the agent interface can be implemented using E-mail (group communications discussed in Col. 40, lines 9-18; Col. 46, lines 6-7). Cook does not specifically disclose that "agent parameters ... are annexed to the main text" of the E-mail. However, Frantz discloses a system in which the main text of an E-mail message from a user (such as a technician) is used to control communications equipment (Col. 4, lines 43-51). In this system, an interpreter parses the parameters contained in the main text of the E-mail in order to generate system commands, and also parses the system messages in order to generate and send E-mail messages back to the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have added the parameters for controlling the agent to the main

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text of the E-mail, since Cook suggested that the group communications (E-mail) could be used for the agent interface, and Frantz taught that the main text of E-mail could be used for passing control parameters.

With respect to the added limitations of claims 2 and 5 (which are dependent on Claim 1) regarding sending sole and plural E-mail messages, it was notoriously well known at the time of the invention that commercially available E-mail programs allow the user to send a single message to a single recipient; and also to send multiple messages to multiple recipients. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have included the ability to send a single message to a single recipient, since it was included in the ubiquitous commercial E-mail programs available at that time, and since Cook suggested that group communications (E-mail) could be used for the agent interface.

Claims 6-7 and 10 are drawn to an apparatus to perform substantially the same steps as in the method of Claims 1-2, and 5, and are rejected similarly.

Regarding the added limitation of Claim 11, it was notoriously well known at the time of the invention that commercially available E-mail programs allow the user to both send and receive messages; otherwise the programs would be useless since this form of communication inherently involves a sender and a receiver (although these can be one and the same entity).

Claim 12 is drawn to an apparatus to perform substantially the same steps as in the method of Claim 11, and is rejected similarly.

With respect to the added limitation of Claim 13, Cook teaches that communications between the agent and the materials controlling it are bi-directional; the parameters are sent to the agents, and the agent set global parameters and return messages confirming actions proposed by the controlling materials (Col. 51, lines 1-5). Regarding independent Claim 14, the recited limitations are substantially a combination of those found in Claim 1 and 11, and are rejected similarly. Regarding Claims 15 and 18, the recited limitations are substantially the same as those of Claim 2 and 5, and are rejected similarly. Claims 19-20, and 23 are drawn to an apparatus to perform substantially the same steps as in the method of Claims 14-18, and are rejected similarly. Regarding Claim 24, the added limitation is substantially the same as that found in Claim 13, and is rejected similarly. Claims 25-26 and 29 are drawn to "program supplying medium" (article of manufacture) that performs substantially the same steps as in the method of Claims 1-2, and 5 and are rejected similarly. Claim 30 is drawn to a "program supplying medium" (article of manufacture) that performs substantially the same steps as in Claim 11, and is rejected similarly. Claims 31-32 and 35 are drawn to "program supplying medium" (article of manufacture) that performs substantially the same steps as in the method of Claim 14-15 and 18, and is rejected similarly.

Claims 36-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Frantz and in further view of Linnett (U.S. Patent No. 5,682,469).

Refer to the rationale relied upon in the rejection of Claims 1-2, 5-7, 10-15, 18-20, 23-26, 29-32, and 35. Furthermore, with respect to independent Claims 36 and 54,

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and dependent Claims 37-53 and 55-71, it is noted that Cook in view of Frantz fails to teach "continuously updating said plurality of agent parameters ...". However, refer to Linnett's columns 3-13, in which he discloses that the behavior of the personal character continuously changes in response to what the user needs. Linnett also teaches the animation, automatic updating, etc. It would have been obvious to one of ordinary skill in the art at the time of invention to combine Linnett's teachings with Cook and Frantz because the animated agent of Linnett would be useful to helping an e-mail recipient to understand applications sent by e-mail.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP 201.15.


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell  
12/10/04

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER